



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/928,893	09/12/1997	HEIKKI HEIKKILA	85940/15	1188

26646 7590 02/13/2002

KENYON & KENYON  
ONE BROADWAY  
NEW YORK, NY 10004

EXAMINER

NAFF, DAVID M

ART UNIT	PAPER NUMBER
----------	--------------

1651

38

DATE MAILED: 02/13/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

08/928 893

Applicant(s)

t/ait kila whp

Examiner

Napp

Group Art Unit

1651

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

## Status

- ☒ Responsive to communication(s) filed on 1-29/01
- ☐ This action is FINAL.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 1, 3, 5-13, 15, 16, 19-21 + 23-34 is/are pending in the application.
- Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 1, 3, 5-13, 15, 16, 19-21 + 23-34 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
  - ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been received.
  - ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_
  - ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other \_\_\_\_\_

Office Action Summary

The amendment of 11/29/01 has been entered. The amendment amended claims 1, 3, 5, 11, 21, 23, 24, 26, 30 and 31, added claims 32-34, and canceled claims 4 and 22.

Claims in the application are 1, 3, 5-13, 15, 16, 19-21 and 23-34.

5 Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1, 3, 5-13, 15, 16, 19-21 and 23-31, drawn to a process of simultaneous of xylitol and ethanol for a starting material of hydrolyzed lignocellulose-containing material, classified in  
10 class 435, subclass 158.

II. Claims 32-34, drawn to a process of simultaneous production of xylitol and ethanol from a starting material of sulphite spent liquor, classified in class 435, subclass 161.

The inventions are distinct, each from the other because: the  
15 processes of the inventions of I and II each require different process steps. In I, the starting material is a lignocellulose-containing material that has been hydrolyzed. This requires hydrolyzing a lignocellulose-containing material as beginning steps. In II, the starting material is a sulphite spent liquor, and there is no requirement  
20 for a hydrolyzed lignocellulose-containing material requiring steps of hydrolyzing a lignocellulose-containing material. Thus, the steps of the processes of I and II are based on two different inventive concepts of processes for simultaneous production of xylitol and ethanol. Each process can be performed without performing the other.

25 Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their

different classification, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even  
5 though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any  
10 amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David M. Naff whose telephone number is (703) 308-0520. The examiner can normally be reached on  
15 Monday-Thursday and every other Friday from about 8:30 AM to about 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, a message can be left on voice mail.

If attempts to reach the examiner by telephone are unsuccessful, the  
20 examiner's supervisor, Mike Wityshyn, can be reached at telephone number (703) 308-4743.

The fax phone number is (703) 305-3014 or 308-4242.


Application Number: 08/928,893  
Art Unit: 1651

Page 4

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

5

DMN  
2/11/02

  
DAVID M. NAFF  
PRIMARY EXAMINER  
ART UNIT 128  
7257